

REMARKS/ARGUMENTS

1. Status of Claims

In the Office Action dated March 8, 2005, Claims 1-19 were noted as pending in the application, Claims 1 and 5 were rejected under 35 U.S.C. 102(b), Claim 3 was rejected under 25 U.S.C 103(a), Claims 7 and 14 were rejected under 35 U.S.C. 11, second paragraph, and Claims 10-19 were rejected under the non-statutory judicial doctrine of double patenting. Claims 2, 4, 6, 8, and 9 were found objectionable, but noted as allowable if rewritten in independent form.

By the present amendment, Claim 4 has been amended and Claim 3 has been cancelled without prejudice.

The rejections and the objections are addressed separately below.

2. Rejection of Claims 7 and 14 under 35 U.S.C. 112, Paragraph 2

On Page 2, Item 1 of the Office Action, Claims 7 and 14 were rejected under 35 U.S.C. 112, paragraph 2, as indefinite for failing to particularly point out and distinctly claim the subject matter of the invention when the phrase "pivotable vertically" was used. In the prosecution of the application of Hippensteel (Appl. No. 10/091,475), of which this application is a continuation, this examiner found that the phrase "pivotable vertically" to be understood by those of ordinary skill in the art and in compliance with 35 U.S.C. 112, paragraph 2. Subsequently a patent issued (U.S. Patent No. 6,764, 432 B2) with claims utilizing the phrase "pivotable vertically" (Claims 10 and 18). In view that the Examiner has previously found the phrase "pivotable vertically" to comply with the requirements of 35 U.S.C., paragraph 2, that claims containing such a phrase are allowable, and that Claims 7 and 14 are identical to such claims allowed, it is requested that Claims 7 and 14 be considered in condition for allowance without amendment. Withdrawal of the rejection of Claims 7 and 14 is requested.

3. Rejection of Claims 10-19 under Double Patenting Based on Hippensteel (U.S. Pat. No. 6,674,432 B2)

On Page 2, Items 2-10 of the Office Action, Claims 10-19 were rejected under the non-statutory judicial doctrine of double patenting, based on Hippensteel (U.S. Patent No. 6,674,432 B2)(“the Hippensteel patent”), but were noted as allowable if a terminal disclaimer was filed in compliance with 37 C.F.R. 1.321(c). Applicant gratefully acknowledges the Examiner’s recognition of the patentability of these Claims, and has attached a terminal disclaimer in compliance with 37 C.F.R. 1.321(c), as suggested by the Examiner, to overcome the rejection. Accordingly, withdrawal of the rejection of Claims 10-19 is requested.

4. Rejection of Claims 1 and 5 under 35 U.S.C. 102(b) based on Chang (U.S. Pat. No. 6,001,046)

On pages 4-5, item 11 of the Office Action, Claims 1 and 5 were rejected under 35 U.S.C. 102(b) based on U.S. Patent No. 6,001,046 (“the Chang patent”). The Chang patent and the reasons that Claims 1 and 5 are patentable over the prior art are addressed separately below.

A. The Chang Patent (U.S. Patent No. 6,001,046)

The Chang patent discloses collapsible exercise bicycle comprising a bicycle seat 42 mounted to a seat support 46 which in turn is pivotably connected to the apparatus base 12 and base members 22, 24. The seat back 44 is mounted to a seat back support 50 which in turn is pivotably connected to the seat support. Thus, the seat back 44 and the seat 42 can be pivoted toward each other into a storage configuration. A connector mechanism is provided to lock the seat 42 and the seat back 55 in an upright user-supporting configuration. A pedal mechanism 34, preferably encased within a shroud, is secured to the base member 22 adjacent the stabilizer bar 14 and extends upwardly from the base member 22. As is conventional, the pedal mechanism 34 includes a pair of cranks 36 coupled to an internal flywheel (not shown) arranged to provide

resistance to rotation. The amount of resistance may be adjusted by a knob 38 mounted to the shroud and connected by an internal cable (not shown) to a resistance providing friction belt (not shown) wrapped around the flywheel. The apparatus 10 further includes a pair of poles 62 positioned across the seat 42 from each other. Each of the poles 62 includes a hand grip 64 at an upper end, preferably covered by cushioning material. At the other end, each of the poles 62 is pivotably connected to the stabilizer bar 16. The pivot pins 68 and the brackets 66 are adapted so that the knobs 70 can be rotated to selectively increase or decrease the friction between the brackets 66 and the poles 62, to either lock the poles 62 in position, release the poles 62, or provide a selected amount of resistance to pivoting of the poles 62. Thus, if desired, the poles 62 can be used to allow the user to have an upper body workout, in addition to the lower body workout provided by the pedal mechanism 34. Alternatively, the poles 62 can be locked to act as stabilizers for the user.

B. Patentability of Claims 1 and 5

Claim 1 as currently stated recites “a bench . . . for a user to lie on their back.” In contrast, in the Chang patent, the seat 42 the seat back 44 operate together as a chair for a user to sit upright. Thus, it is submitted that Claim 1 as currently stated is patentable over the Chang patent for this reason.

In addition, Claim 1 as currently stated recites “a pair of independently adjustable arm exercise mechanisms mounted on a first end of said frame, each of said arm mechanisms including a rotatable arm to be rotated around an axis of rotation by the user's arms, each said rotatable arm including a shaft portion that is separate and distinct from the shaft portion of said other rotatable arm, each said shaft portion defining said axis of rotation of said rotatable arm.” In contrast, the Chang patent discloses a set of poles 62 which are pivotably connected to the stabilizer bar 16. The user's arms can only move in a back and forth, not a circular, motion. Hence it is submitted that Claim 1 as currently stated is patentable over the Chang Patent for this additional reason.

Claim 5, as currently stated, is dependent on Claim 1 as currently stated and includes all the limitations of that claim. The features of Claim 5, under the limitations of Claim 1 on which

it depends, are not disclosed in the Chang patent for the reasons stated above with respect to Claim 1 as currently stated and it is submitted that Claim 5 is patentable over the prior art.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Accordingly, since each and every element of Claims 1 and 5, as currently stated, are not disclosed in the Chang patent, it is submitted that Claims 1 and 5, as currently stated, are patentable over the prior art. Withdrawal of the rejection of Claims 1 and 5, as currently stated, is requested.

5. Rejection of Claims 1 and 5 under 35 U.S.C. 103(a) based on Chang (U.S. Pat. No. 6,001,046)

On Page 5, Item 12 of the Office Action, Claim 3 was rejected under 35 U.S.C. 103(a) based on the Chang patent.

By the present amendment, Claim 3 has been cancelled without prejudice so that the rejection of Claim 3 is now moot. Withdrawal of the rejection of Claim 3 under 35 U.S.C. 103(a) is requested.

6. Objectionable Claims

On Page 5, Item 13 of the Office Action, Claims 2, 4, 6, 8, and 9 were found objectionable for dependency from a rejected base claim, but were noted as allowable if rewritten in independent form to include the limitation of the base claim and any intervening claims. Applicant gratefully acknowledges the Examiner's recognition of the patentability of these claims. However the reasons that Claims 2, 6, 8, and 9, as currently stated, and Claim 4, as currently amended, should be allowed are addressed separately below.

A. Patentability of Claims 2, 6, 8, and 9

Claims 2, 6, 8, and 9 were found objectionable because of their direct or indirect dependency on Claim 1. Thus, for the reasons stated above with respect to the allowance of Claim 1, it is submitted that the rejection of Claims 2, 6, 8, and 9 will be moot once Claim 1 is allowed. Therefore, when the Examiner withdraws the rejection of Claim 1, withdrawal of the objection to claims 2, 6, 8, and 9 is also requested.

B. Patentability of Claim 4

Claim 4 was found objectionable because of its direct dependency on rejected Claim 3 and its indirect dependence on Claim 1. By the present amendment, Claim 4 has been amended to include all the limitations of intervening Claim 3 and to depend on Claim 1. Furthermore, for the reasons stated above with respect to the allowance of Claim 1, it is submitted that the rejection of currently amended Claim 4 will be moot once Claim 1 is allowed. Therefore, when the Examiner withdraws the rejection of Claim 1, withdrawal of the objection to currently amended Claim 4 is also requested.

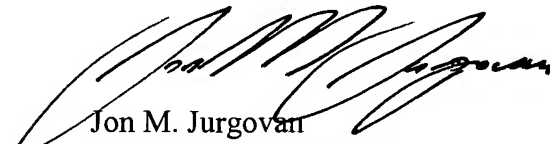
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7. Conclusions

It is submitted that Claims 1 and 5 are patentable over the prior art without amendment. Consequently, it is submitted that any claims dependent on Claim 1 should not be deemed indefinite by the Examiner. In addition, Claim 4 has been amended to include the limitation of the base claim to overcome the objection to the Claim. Furthermore, a terminal disclaimer is included to overcome the rejection of claims 10-19. Accordingly, it is submitted that all pending claims have been cancelled or are now in condition for allowance. Reconsideration of Claims 1, 2, and 4-19 and a Notice of Allowance are earnestly solicited.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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